



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,057	06/15/2005	Thomas Hasskerl	272911US0PCT	4272
22850	7590	03/19/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
NAKARANI, DHIRAJLAL S				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
03/19/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/539,057

Applicant(s)

HASSKERL ET AL.

Examiner

D. S. Nakanari

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :09/07/2005, 12/06/2005, 05/04/2006, 06/08/2006 and 09/21/2007..

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/538,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because both application claims a plastic article which inhibits water droplet formation comprising identical substrate, an intermediate layer and an identical inorganic coating. The present invention require intermediate layer formed from a mixture comprising solvent with a specified volatility index, anionic flow control agent and nonionic flow control agent while the invention of U. S. Patent Application 10/538,887 requires intermediate layer formed from a mixture comprising two polymers having specified water contact angels. The invention as

Art Unit: 1794

claimed in the present application is an open language inclusive of unspecified components. The solvent is not present in the final product. The U.S. Patent Application 10/538,887 suggests use of solvent and conventional flow control agents at page 20. Therefore it would have been obvious to a person of ordinary skill in the art to optimize flow property of the coating composition by using a mixture of flow control agents.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1794

5. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krautter et al (U. S. Patent 4,576,864) in view Faverolle et al (U. S. Patent 6,503,631 B1).

Krautter et al disclose a water spreading plastic article comprising a substrate having thickness from 1 mm to 50 mm such as polycarbonate, polymethylmethacrylate (Col. 8, line 30 to col. 9, line 4), coated with an adhesive coating composition a mixed polymer of butylmethacrylate and of methylmethacrylate and an inorganic coating over the adhesive layer (Example 1, col. 5, line 9 to col. 7, line 28 and col. 4, line 15 to col. 5, line 6). The thickness of the adhesive coating is 0.10 μm (i. e. 100 nm) and the thickness of the inorganic coating is 0.15 μm (i. e. 150 nm) (Example 1). Thus total thickness of the adhesive layer and the inorganic layer is 0.25 μm (i. e. 250 nm). Krautter et al fail to disclose claimed flow control agents and claimed physical properties of the substrate and the coatings.

Faverolle et al disclose a comprising a substrate such as polycarbonate, polymethylmethacrylate (col. 5, lines 1-9), primer coat comprising two polymers one of which is a polymer of butyl acrylate and another polymer of methylmethacrylate and inorganic coating over the primer coat. Faverolle et al's primer coating composition comprises anionic surfactant and nonionic surfactant at 1:1 ratio (Col. 8, lines 5-68 and col. 4, lines 53-63).

Therefore it would have been obvious to a person of ordinary skill in the art at the time of this invention made to utilize disclosure of Faverolle et al in the invention of Krautter et al to use two surfactant as taught by Faverolle et al since both, the

Art Unit: 1794

composition of primer coat of Faverolle et al and an adhesive coat of Krautter et al are based on an acrylic polymers. Neither Krautter et al nor Faverolle et al disclose flow coating method. However in absence of showing criticality of the coating method person of ordinary skill in the art would use any known coating method to coat article. The claimed physical properties not disclosed prior art are deemed to be within the skill of the art to optimize for the given application.

No claims are allowed.

6. Receipt of Information Disclosure Statements filed September 07, 2005, December 06, 2005, May 04, 2006, June 08, 2006 and September 21, 2007 is acknowledged. All recited documents have been made of record. Duplicate recited documents have been crossed-out. The non-English document DE 2 161 645 has been considered to the extent of its description provided in the instant specification. The non-English document EP 0149 182 is considered equivalent to U. S. Patent 4,576,864.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. NAKARANI whose telephone number is (571) 272-1512. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RENA DYE can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S. Nakarani/
D. S. Nakarani
Primary Examiner
Art Unit 1794

DSN
March 8, 2008.